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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/877,047	06/11/2001	Akira Oomori	35.G2819	2412
5514	7590	12/10/2004	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			LEE, TOMMY D	
			ART UNIT	PAPER NUMBER
			2624	

DATE MAILED: 12/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/877,047

Applicant(s)

OOMORI, AKIRA

Examiner

Thomas D. Lee

Art Unit

2624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Specification***

2. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1, 4-9, 12 and 13 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for storage of image data corresponding to a set mode, does not reasonably provide enablement for mode setting means. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

A single means claim, i.e., where a means recitation does not appear in combination with another recited element of means, is subject to an undue breadth rejection under 35 U.S.C. 112, first paragraph. *In re Hyatt*, 708 F.2d 712, 714-715, 218

Art Unit: 2624

USPQ 195, 197 (Fed. Cir. 1983) (A single means claim which covered every conceivable means for achieving the stated purpose was held nonenabling for the scope of the claim because the specification disclosed at most only those means known to the inventor.). When claims depend on a recited property, a fact situation comparable to *Hyatt* is possible, where the claim covers every conceivable structure (means) for achieving the stated property (result) while the specification discloses at most only those known to the inventor. (MPEP § 2164.08(a))

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-15 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,361,143 (Nakayama et al.).

Regarding claims 1-6, Nakayama et al. disclose an image processing apparatus comprising mode setting means for setting one of a first mode, in which color image data and monochrome image data are stored as document image data in a memory medium, and a second mode, in which the monochrome image data is stored as the document image data in the memory medium (in multi-color mode, black (monochrome) data and color data read and stored (column 4, lines 26-48); in monochromatic mode, only black data read and stored (column 4, lines 49-55)); transmission means for transmitting, from among the color image data and the monochrome image data stored

Art Unit: 2624

in the memory medium, image data suitable for a destination apparatus (when other party is capable of multi-color printing, integrated data and data of each color transmitted (column 4, line 67 – column 5, line 3); otherwise, either only integrated data or monochromatic data are transmitted (column 5, lines 21-28)); and determining means for determining whether a document is one of a color document and a monochrome document (judgment of color mode (column 4, lines 26-31)), wherein, when said determining means determines in the first mode that the document is a color document, the color image data and the monochrome image data are stored as the document image data in the memory medium (storage of both types when multi-color mode is judged (column 4, lines 26-48)). A document is scanned as a color image and as a monochrome image, in the first mode, and a document is scanned as the monochrome image, in the second mode (as mentioned above). Image data for a plurality of documents, which are continuously scanned, are stored in the memory medium (continuous scanning and storage until last page is reached (column 4, lines 56-61)). The memory medium includes a plurality of partitioned image storage regions, and the document image data is stored in a designated one of the plurality of image storage regions (P file stores integrated data, data for blue color and those for a red color (column 4, lines 47-48; Figs. 2-a and 2-b)).

Regarding claims 7-13, Nakayama et al. disclose an image transmitting apparatus comprising mode setting means for setting one of a first mode, in which image data in a plurality of formats are stored as document image data in a memory medium, and, from among the image data in the plurality of formats, image data in a

Art Unit: 2624

format suitable for a destination apparatus is transmitted to the destination apparatus, and a second mode, in which image data in a single format is stored as the document image data in the memory medium, and the image data in the single format stored in the memory medium is transmitted to the transmission destination (in multi-color mode, black (monochrome) data and color data read and stored (column 4, lines 26-48); in monochromatic mode, only black data read and stored (column 4, lines 49-55); when other party is capable of multi-color printing, integrated data and data of each color transmitted (column 4, line 67 – column 5, line 3); otherwise, either only integrated data or monochromatic data are transmitted (column 5, lines 21-28)); and determining means for determining a format of a document, wherein image data in a format corresponding to a determination result obtained by said determining means is stored in the memory medium, in the first mode (judgment of color mode (column 4, lines 26-31); storage of both types when multi-color mode is judged (column 4, lines 26-48)). A document is scanned in the plurality of formats (a color image and a monochrome image) in the first mode, and a document is scanned in the single format (a monochrome image) in the second mode (as mentioned above). Said determining means determines whether the document is one of a color document and a monochrome document (judgment of color mode (column 4, lines 26-31)); and when said determining means determines in the first mode that the document is a color document, color image data and monochrome image data are stored as the document image data in the memory medium (storage of both types when multi-color mode is judged (column 4, lines 26-48)). Image data for a plurality of documents, which are continuously scanned, are stored in the memory

Art Unit: 2624

medium (continuous scanning and storage until last page is reached (column 4, lines 56-61)). The memory medium includes a plurality of partitioned image storage regions, and the document image data is stored in a designated one of the plurality of image storage regions (P file stores integrated data, data for blue color and those for a red color (column 4, lines 47-48; Figs. 2-a and 2-b)).

Claims 14 and 15 are method claims corresponding to above-rejected apparatus claims 1 and 7, respectively. The steps recited in these claims are provided in the facsimile apparatus discloses in Nakayama et al., as set forth above.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakayama et al.

Claims 16 and 17 recite a program storage medium storing a program for performing the steps of above-rejected claims 14 and 15, respectively. While Nakayama et al. do not disclose a program storage medium, it is generally well known to one of ordinary skill in the art that processing steps are commonly stored as a program in a memory disk, or the like, to be read by a central processing unit of a apparatus, and it would have been obvious to provide a program storage medium in Nakayama et al., so as to enable the apparatus to perform the processing steps.

Art Unit: 2624

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent 5,392,133 (Nakajima) discloses an apparatus and method for transmitting image data in a format adapted to a condition of a destination.

U.S. Patent 5,485,283 (Kaneko) discloses an image transmitting apparatus for transmitting color image data in a color transmitting mode or a monochromatic transmitting mode.

U.S. Patent 5,696,598 (Yoshida et al.) discloses a color image communication apparatus capable of accommodating monochrome communication partners.

U.S. Patent 5,719,686 (Sakamoto et al.) discloses transmission of an entered image, in the color mode, without passing memory means, and , in the monochromatic mode, after storage once in the memory means.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas D. Lee whose telephone number is (703) 305-4870. The examiner can normally be reached on Monday-Friday (7:30-5:00), alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (703) 308-7452. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



Art Unit: 2624

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thomas D. Lee  
Primary Examiner  
Art Unit 2624

tdl  
December 9, 2004